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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

10397-341

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Filed via EFS

Application Number

10/078,815

Filed

February 19, 2002

First Named Inventor

Adam R. Schran

Art Unit

2157

Examiner

Avi M. Gold

Applicant requests review of the ~~final rejection~~ ^{twice rejected} in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 35,039☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Clark Jablon

Signature

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215-965-1293

Telephone number

October 5, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

1. There is a clear error in the Examiner's outstanding rejection of independent claims 7 and 34 because the applied references do not disclose or suggest at least the limitations of step (d) "automatically conducting one or more performance tests using the selected network configuration settings during the established network connection," and step (e) "repeating steps (c) and (d) for one or more other groups of network configuration settings during the established network connection"

The Examiner relies upon the combination of Rehkopf and Tate as allegedly disclosing these two claim limitations. Applicants fully responded to the Examiner's rejection in Applicants' "Amendment Accompanying RCE" filed March 28, 2007, hereafter, referred to as "the 3/28/07 Amendment."¹ See sections 1-4 on pages 12-16 of the 3/28/07 Amendment, particularly, section 4. Accordingly, Applicants will not repeat these arguments.

In sections 5-9 on pages 10-12 of the outstanding rejection, the Examiner responded to these arguments. However, none of the Examiner's responses refute Applicants' arguments. The responses are addressed as follows in accordance with their respectively numbered paragraphs in the outstanding rejection:

6. The Examiner's analysis of the applied references was based on the combination of the references as applied by the Examiner, particularly, the manner in which the Examiner modified Rehkopf based on the disclosures in Tate (see the first full paragraph on page 17 of the 3/28/07 Amendment²). Applicants did not attack the references individually. Thus, the Examiner's citation of well-established case law that such an attack on the applied references is improper is not relevant to this matter.

7. Applicants did not argue that Rehkopf and Tate are "nonanalogous art." Again, see the first full paragraph on page 17 of the 3/28/07 Amendment where Applicants implicitly state that no such argument is being made.

8. Applicants argued that Rehkopf and Easty are non-analogous art in traversing the rejection of dependent claims 13 and 40. This argument is discussed in further detail below. However, this argument has nothing to do with the rejection of independent claims 7 and 34, which was not based on Easty.

¹ The Pre-Appeal guidelines request that prior submissions be referred to by paper number. However, no paper numbers are available to Applicants, nor does any other paper numbering scheme appear on the USPTO's PAIR web site.

² "To summarize, Applicants are not asserting that Rehkopf cannot be modified based on disclosures in Tate. Instead, Applicants are asserting that the modifications suggested by Tate would not lead to Applicants' claimed invention. The following table summarizes Applicants' arguments set forth above." (first full paragraph on page 17 of the 3/28/07 Amendment)

9. The Examiner has correctly identified the case law principles regarding hindsight as discussed in MPEP 2145, Section X. Part A. However, Applicants' argument is that the modifications to Rehkopf were made solely based on knowledge gleaned only from applicant's disclosure, and not knowledge gleaned from Tate. The rejection is thus a textbook example of improper hindsight reconstruction of Applicants' invention. Stated another way, the Examiner did not merely use knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made to modify Rehkopf. Use of such knowledge is entirely permissible for hindsight reconstruction of the claimed invention. Specifically, as discussed on pages 16-17 of the 3/28/07 Amendment,

Furthermore, a base reference cannot be modified if doing so would destroy its intended manner of operation. MPEP 2143.01. The Examiner's proposed modification to Rehkopf would clearly destroy Rehkopf's intended manner of operation and thus is improper. Specifically, the Examiner's proposed modification to Rehkopf would require eliminating Rehkopf's initial set of values and different floating variables, and replacing it with different groups of network configuration settings. Rehkopf's invention concept is summarized in the Abstract which reads as follows...This invention concept, including the concept of a "floating variable," is repeated throughout the entire disclosure and claims in Rehkopf. While it theoretically might be possible to use different groups of network configuration settings and maintain the floating variable concept in Rehkopf, ***there is no suggestion in either of the applied references regarding how this would be done.*** Furthermore, such a modification would clearly be an improper hindsight reconstruction of Applicants' invention. (underlining in the original, bolded and italicizing added for emphasis)

In sum, the Examiner used the claimed invention as a roadmap to modify Rehkopf in a manner that was nowhere disclosed or suggested by the prior art of record.

Regarding the arguments to claims 7 and 34, the Examiner asserts that column 2, line 21 through column 3, line 11 discloses conducting performance tests during the established network connection. Here, the Examiner misconstrued Applicants' argument presented in section 3 on page 15 of the 3/28/07 Amendment. The performance tests that are run by Rehkopf during an established network connection are not run using a plurality of groups of network configuration settings, as required by claims 7 and 34. To the contrary, Rehkopf's floating variable and fixed other system performance variables teaches away from this claim limitation. Likewise, modifying Rehkopf in view of Tate would also not lead to a system that

would meet this claim limitation for at least the reasons given in section 3 on page 15 of the 3/28/07 Amendment.

In sum, the Examiner has failed to rebut Applicants' explanation of why the above-highlighted limitations in claims 7 and 34 are not disclosed or suggested by the applied references.

2. There is a clear error in the Examiner's Final Rejection of claims 13 and 40 because Easty is non-analogous prior art, and thus cannot be properly combined with Rehkopf to provide the limitations of these claims

The Examiner relies upon Easty as allegedly disclosing the limitations of claims 13 and 40. Applicants fully responded to the Examiner's rejection in sections 5-6 (pages 17-19) of the 9/5/07 Amendment. Section 5 explains why these references are believed to be in non-analogous art areas. Accordingly, Applicants will not repeat these arguments.

In section 8 on page 11 of the outstanding rejection, the Examiner responded that Rehkopf and Easty are analogous prior art because both relate to "data transferred over a network." While the Examiner has properly identified the well-known test for "analogous art," the Examiner's explanation that both relate to "data transferred over a network" is an overly broad characterization of the references that bears no relationship to the claim limitation that led the Examiner to rely upon Easty. Millions of prior art references relate to "data transferred over a network." However, having this fact in common does not provide sufficient motivation to identify all such references as being analogous art for purposes of combining such references to meet any limitations in a claim, including limitations that do not relate to network data communications. The Examiner's reasoning is no different in nature than arguing that all references that have "computers" or "memory" in them are analogous art, and thus are properly combinable to meet claim limitations that have nothing to do with computers or memory.

3. There is a clear error in the Examiner's Final Rejection of the dependent claims.

The dependent claims are believed to be allowable because they depend upon respective allowable independent claims, and because they recite additional patentable steps. Specific additional patentable steps in dependent claims 13 and 40 are highlighted above.

4. Each of the clear errors identified above highlights the Examiner's omission of one or more essential elements needed for a prima facie rejection.
5. None of the arguments above depend upon interpretations of prior art teachings or claim scope issues. For at least the reasons set forth above, all of the outstanding rejections should be withdrawn.